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Esther Breuning

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EXAMINER

WILSON, MICHAEL H

ART UNIT

PAPER NUMBER

1786

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. The proposed amendment to the claims, which cancels claims 3-5, 7, 23, 25, and 37, and amends claims 2, 6, 8-14, 17-22, 24, 26, 32, 34, 35, and 38, and adds new claims 40 and 41, in the reply dated 14 June 2010 will NOT be entered however the amendment fails to place the application in condition for allowance.
2. The proposed amendment will not be entered because the amended claims change the scope of the claims and present a new combination of limitations not previously considered.
3. Were the proposed amendment entered, it appears to overcome the rejections under 35 U.S.C. 112, second paragraph, but does not appear to overcome the rejection of Roberts et al. (US 200/0062930 A1) in view of Hu et al. (US 6,670,054 B1). New independent claim 40 appears to be a combination of old claims 4 and 23, previously rejected by Roberts et al. (US 200/0062930 A1) in view of Hu et al. (US 6,670,054 B1).
4. Applicant's arguments filed 14 June 2010 have been fully considered but they are not persuasive.

Applicants argue that Roberts et al. does not disclose a separate bridged carbazole unit of the formula (II) however as stated in the previous Office Action Roberts et al. does disclose such a mixture in paragraph [0391].

Applicants also argue that the examiner has not shown why one of ordinary skill in the art would substitute the carbazole of Roberts et al. with the one of Hu et al. However, as discussed in MPEP§ 2144, if the facts in a prior legal decision are

Art Unit: 1786

sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Case law holds that the mere substitution of an equivalent (something equal in value or meaning, as taught by analogous prior art) is not an act of invention; where equivalency is known to the prior art, the substitution of one equivalent for another is not patentable. See *In re Ruff* 118 USPQ 343 (CCPA 1958). Hu et al. clearly teaches several linking groups in columns 9-11 which overlap with the presently claimed groups and clearly teaches dicarbazole compounds with these linking groups to be suitable for the same purpose. Further equivalent and interchangeable does not mean identical, but that the groups are similar, any change to a compound will alter the compounds properties. Replacing a group with another that is equivalent and interchangeable will give a compound one of ordinary skill in the art could reasonably expect to have similar properties and be suitable for the same purpose. The specific properties may be slightly different from the original compound but the overall property would remain the same. For example a hole transporting compound may have slightly more or less hole mobility when equivalent groups are interchanged, but the compound would still remain hole transporting.

Applicants also argue that none of the secondary references disclose the combination of claim limitations (A) to (C) (on page 31 of Remark). However the rejections of record do not rely of a secondary reference to teach this combination of limitations. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

Art Unit: 1786

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Additionally Applicants argue that the statement that modifications of the prior art to meet the claimed invention would have been "obvious to one of ordinary skill in the art at the time the invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. However the examiner notes that both motivation to combine and the reasons one of ordinary skill in the art would reasonably expect success have previously been articulated in the rejections of record. Therefore the rejections do not merely make the conclusory statement, but articulate reasoning with rational underpinning to support the conclusion of obviousness.

Further Applicants argue that the Examiner cannot selectively pick and choose from the disclosed parameters without proper motivation as to a particular selection; and asserts that the mere fact that a reference may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention obvious unless the prior art suggested the desirability of such modification. Thus, applicants argue that that the examiner used impermissible hindsight reasoning. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of

Art Unit: 1786

ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The rejections of record only use knowledge which was within the level of ordinary skill at the time the claimed invention was made with motivation to combine coming explicitly or implicitly from the cited references and not from applicant's specification. Therefore the rejections of record are not based on impermissible hindsight reasoning.

Last Applicants assert evidence of "better results", while this argument relates to the claim amendment which is not entered the standard for overcoming an obviousness rejection is unexpected results, not better results.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL WILSON whose telephone number is (571) 270-3882. The examiner can normally be reached on Monday-Thursday, 7:30-5:00PM EST, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1786

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHW

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787